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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/632,774	08/04/2000	Stacy Haituka	72189/9813B	2126

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EXAMINER

GRAVINI, STEPHEN MICHAEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 03/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/632,774

Applicant(s)

HAITSUKA ET AL.

Examiner

Stephen M Gravini

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 & 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Requirements for Information

37 CFR 1.105 states: (a) (1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under §1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

- (I) Commercial databases : The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.
- (ii) Search : Whether a search of the prior art was made, and if so, what was searched.
- (iii) Related information : A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.
- (iv) Information used to draft application : A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

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(v) Information used in invention process : A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) Improvements : Where the claimed invention is an improvement, identification of what is being improved.

(vii) In Use : Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(I), (iii), and (vii) of this section may also be applied to such assignee.

(3) Any reply that states that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested will be accepted as a complete reply.

(b) The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.

(c) A reply, or a failure to reply, to a requirement for information under this section

will be governed by §§ 1.135 and 1.136.

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The Office is requiring submission of information reasonably necessary to properly examine and treat the claimed subject matter under Rule 105. Of particular interest is information used in drafting the present operation including information related to the field of endeavor or business practices used by applicants' professional business ventures, to show the information used in the invention process, and identification of any use of the claimed invention known to the inventor at the time the application was filed notwithstanding the date of the use. Since the application is filed as a small entity status, along with the fact that the applicants are associated with SolVisions Technologies, International which is in the business of the claimed invention, it appears that it would be appropriate to require the applicants to provide information necessary to ensure a quality examination may be performed by the Office.

Information Disclosure Statement

The information disclosure statement filed September 1, 2000 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. No copy of applicants' cited reference AA was included with the information disclosure statement and can not be considered.

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The information disclosure statement filed October 2, 2001 and September 1, 2000 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered. References U through Z filed September 1, 2000 and reference W filed on October 2, 2001 have not been translated, have not been explained with respect to relevance, and have not been considered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 1-6 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Petrecca et al. (US 5,781,894).

Claims 7-10 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Golden et al. (US 5,761,648).

Claims 11-14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by West et al. (US 5,845,259).

Claims 15-20 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Wendkos (US 5,983,196).

Claims 21-25 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by LeLonde et al. (US 5,283,731).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over examiner's personal experience with a system or method of displaying information to a user of an online service using a client application on a local device, the local device including an input device and an output device, the local device accessing an online server associated with the online service and providing interaction with the online service as provided by the Patent Office desktop computer used to search, examine, and develop Office actions for patent applications. The claimed advertisements and sponsorship data or information are considered merely non-functional descriptive material, which is interchangeable with data and information, which will be discussed infra. The claimed invention under examiner experience is based on the broadest reading of the claims under the *Graham* decision. Since at least 1998, examiner has experienced search, examination, and development Office actions for patent applications, which has performed the claimed system and method comprising:

client application activating;

client application commencing an online session with the online server;

the online server transmitting data to the client application, the data comprising a object including a resource locator associated with a label to be displayed and a resource locator associated with a click-through of the label or label displayed;

client application causing a client window to be displayed on the output device;

client application displaying a label on the client window, the label comprising a hypertext link, wherein, when the user clicks through on the label, the client application causes the local device to access the resource locator associated with a click-through of the label or accessed if a user clicks on the label;

client application causing a first information to be displayed in the client window, wherein the client application retrieves the first information from a memory cache to the local device;

online server transmitting a second information to the client application optionally to a local device;

optionally the client application monitoring the user's interaction with the client window and assembling a usage history for the user based on the user's interaction, the usage history being descriptive of the subject matter of the data that the user accessed from the web server with an instruction to user terminate the online session and exit window display; and

client application causing the first or second information to be displayed in the client window are part of examiner's personal experience. Examiner's personal experience also includes the claimed PSTN communication channel, local device server authorization, URL click-through web page, title bar label, play list display, and dial-up

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communication. As a premise, advertisements and sponsorship, as claimed and as discussed in the specification are merely various presentation formats of data or information. An advertisement, as discussed in the specification and as claimed is defined to include targeted information or data for a select group of users. In this case the programs used to search, examiner, and develop Office actions are considered patentably equivalent to the claimed advertisements and/or sponsorship. For example the STN or DIALOG databases or the ActionWriter/ FormWriter programs have an icon in a patent examiner desktop toolkit such that those programs and icons function patentably equivalent to the claimed advertisements and/or sponsorship. Both function in substantially the same way, with substantially the same result, using substantially the same method or means. The claimed feature of client application activating is considered functionally equivalent to examiner opening a desktop program to search or examine a patent application. The claimed step of client application commencing an online session with the online server is considered functionally equivalent the examiner connecting to a web server for access to an off site database, such as STN or DIALOG. The claimed step of an online server transmitting data to the client application, the data comprising a object including a resource locator associated with a label to be displayed and a resource locator associated with a click-through of the label or label displayed is considered equivalent to the examiner providing username and password information to access the STN or DIALOG databases. The claimed step of client application causing a client window to be displayed on the output device is considered equivalent to the desktop workstation display such that an application examination can occur. The

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claimed step of client application causing a first information to be displayed in the client window, wherein the client application retrieves the first information from a memory cache to the local device is considered functionally equivalent to programs used to remember usernames, passwords, or saved Office actions to allow examiner automatic access for continuing an Office action after an attorney-examiner interview or the like. The claimed online server transmitting a second information to the client application optionally to a local device is considered equivalent to the server that examiner's desktop workstation must access for searching and/or examination. The claimed client application monitoring the user's interaction with the client window and assembling a usage history for the user based on the user's interaction, the usage history being descriptive of the subject matter of the data that the user accessed from the web server with an instruction to user terminate the online session and exit window display and client application causing the first or second information to be displayed in the client window is considered functionally equivalent to printing out search results and/or Office actions for mailing such that the descriptive history of the user's session is captured and saved. The claimed PSTN communication channel, local device server authorization, URL click-through web page, title bar label, play list display, and dial-up communication are considered part of hotel travel with frequent flyer miles included in examiner's experience. The claimed invention contains non-functional descriptive material features, such as advertisements and sponsorship data or information which is an obvious variation to the examiner's experience such that the examiner will use Official notice to obviate that claimed subject matter. Examiner's experience is considered to

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teach the claimed invention. Examiner's experience does not expressly show the non-functional descriptive material features including advertisements and sponsorship data, label, or information. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The advertisements and sponsorship data, label, or information steps would be performed the same regardless of the information or data claimed. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 32 F. 3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to manipulate data or information, particularly, advertisements and sponsorship data, label, or information having any type of content, because such data does not functionally relate to the steps in the method or system claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention. The motivation to combine applicants' claimed invention with the services offered by employing the services of a online communication such as manipulating data or information, while transferring information, clearly shows the obviousness of the claimed invention. One would also be motivated to combine the teachings of examiner's experience with current computer and network innovations available such that much of an examiner's duties can be carried out in a more efficient manner through computer technology than manually inserting advertisements and/or sponsorship. One would be further motivated to combine examiner's experience with

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advertisements and sponsorship data, label, or information to allow better communication forum for displaying advertisements or sponsorship data or information.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-45 of copending Application No. 09/324,747, claims 1-36 of copending Application No. 09/467,751, or claims 1-6 and 8 of copending Application No. 09/393,391. Although the

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conflicting claims are not identical, they are not patentably distinct from each other because each of those applications contain obvious variations of server/ computer interaction to send and receive advertising data. Although the claim language is slightly different in each application, all perform the same function, with the same method or means, yielding the same result.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose voice telephone number is (703) 308-7570 and electronic transmission / e-mail address is "steve.gravini@uspto.gov". Examiner can normally be contacted Monday through Friday from 6:00 a.m. to 3:30 p.m. **If applicants choose to send information by e-mail, please be aware that confidentiality of the electronically transmitted message cannot be assured.** Please see MPEP 502.02. Information may be sent to the Office by facsimile transmission. The facsimile transmission telephone numbers for TC-3600 are:

After-final	(703) 872-9327
Official	(703) 872-9306
Non-Official/Draft	(703) 872-9325

Steve Gravini
STEPHEN GRAVINI
PRIMARY EXAMINER

smg
March 2, 2004